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Carol Ann

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EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3689

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|-----------------------------------|--|
| Office Action Summary | Application No. 09/887,781 | Applicant(s) ANN ET AL. | |
| | Examiner Tan Dean D. Nguyen | Art Unit 3689 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,9,10 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,9,10 and 13-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed 2/20/08 has been entered. Claims 1-2, 4, 6, 9-10, 13-30 are pending and rejected below. The claims consist of 3 independent claims which comprises 2 system claims: 1-2, 4-6, 18-29, and 30, and a method claim: 9-10, 13-17. Claim 1 is broadest and will be examined first.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-2, 4-6, 18-29 (system), and 30 (system) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, not a method (process), machine (apparatus), manufacture (article, product), or composition of matter.**

As of 2/20/08, claim 1 is as below:

1. (Currently Amended) An enterprise architecture model of a business and the business's information technology, the enterprise architecture model stored in, manipulated by and implemented in a data processing system, comprising:

a) a business architecture having a plurality of business components within a database wherein each business component has an operational linkage with at least one other business component;

b) an information technology architecture comprising at least one application software component that processes at least business information data from the business architecture, and a plurality of information technology components within the database wherein each information technology component has an operational linkage with at least one other information technology component;

c) a linkage assessment tool that evaluates an impact on one of the architectures resulting from a change in at least one component in the other of the architectures; and

d) an impact assessment work product that outputs the results of the linkage assessment component.

Note: for convenience, letters (a)-(d) are added to the beginning of each step.

As shown above, the system of claims 1-2, 4-6, 18-29, and similarly claim 30 are merely structures (information or data) stored in a database which have no patentable weight in an apparatus (machine) claim. Moreover, they are merely modeling instruments comprising a disembodied abstract ideas and do not produce any tangible, concrete and repeatable results. An apparatus claims comprises element or devices or structural elements such as a computer or processor.

Claim Rejections - 35 USC § 112

3. Claims 9-10, 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(1) In claim 9, it's not clear how the "organization direction component" is used in the body of the claim. Claim element should not stay there in the claim and doing nothing. It should be connected to the body of the claims like any other components.

(2) In the 3rd linking step, it's not clear what the term "data" refers to. There are several "data" terms previous above the step.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 9-10, 13-17 (method) are rejected under 35 U.S.C. 103(a) as being unpatentable over CORNELIUS ET AL in view of ADLER (US 2002/0169658).

As for claim 9, similarly, CORNELIUS ET AL discloses an enterprise system for modeling the operation of a business enterprise and its information processing, the system comprising:

- * storing a first architectural portion integrated in a database, the first architectural portion comprising business organization directions (operations) and principles (objectives) of the business enterprise;

{see col. 41, lines 61-67, col. 42, lines 1-27, col. 51, lines 3-60, Fig. 81, Fig. 97}

- * storing a second architectural portion integrated in the database, the second architectural portion comprising an business information components and processes components which the business uses to conduct its business; and

{see col. 42, lines 5-10, col. 44, lines 45-62, Fig. 81, 8102, Fig. 97}

- * storing data which deals with the information technology architecture of the organization in the database/repository, the architecture comprising application software and data;

{see Fig 81, 8102, Fig. 97, col. 42, lines 5-10, col. 44, lines 45-62}

- * Assessing the impact upon the changes to the business architecture on the information architecture of the organization or vice versa prior to implementation;

{see col. 54, lines 24-42, col. 59-60, col. 61, lines 12-35, col. 68, lines 5-20, cols. 86-88, which deal with "implementation" issues, cols. 96-97, Fig. 81, 8120}

As for the linking features, they are inherently included in the teachings of CORNELIUS ET AL as shown in Fig. 81, and cols. 67-68 since it appears that all of the business components are related/tied to each other so that an impact analysis of a business component can be carried out upon changes of other business component.

CORNELIUS ET AL fairly teaches the claimed invention except for explicitly disclosing the use a database for storing structures (a) and (b). Note that it appears that the Framework which includes managing change shown in Fig. 81 is carried out on a single database, Fig. 81, 8102. CORNELIUS ET AL also discloses the use of more than one database, see Fig. 97. Alternatively, the selection of the number of databases varies cost, space, degree of complexity or uniformity, speed, etc. and it would have been obvious to a skilled artisan to use the same database for storing structures (a) and (b) above to reduce cost and/or improving uniformity. Note, also on col. 42, lines 5-25, CORNELIUS ET AL discloses the use of various business operations, such as (a) Information Management processing system, in the Process Model. The use of other well known business processes or processing system such as Information Technology processing system in the Process Model above would have been obvious as mere selection of other well known business process or structures of the business enterprise. Moreover, the term "information technology" is non-functional in a data processing.

CORNELIUS ET AL fairly teaches the claimed invention except for the term "computerized" method in the preamble or the method is carried out using a computer.

This is fairly agreed by the applicant on page 16 of the response filed on 2/20/08 which says that the CORNELIUS ET AL method appears to be carried out manually which takes a long time with a lot people involved.

In a similar business modeling process for evaluating business alternatives or opportunities, ADLER discloses the carrying out of the complex modeling using computer or distributed computer network and/or with Internet wide area network communication hardware and software to provide well known web benefits such as real-time data and management and remote access or to allow unattended execution of various business operation {see paragraphs [0164-0165], or [0165-0167]}. It would have been obvious to modify the manual operation of the business modeling operation of CORNELIUS ET AL with the computerized modeling operation of ADLER for at least one of the well known benefit cited above such as unattended execution of various business operation or with Internet wide area network communication hardware and software to provide well known web benefits such as real-time data and management and remote access by users of different locations.

As for dep. claim 10 (part of 9 above) which deal with an element/item for accessing the data for changing/modifying business element, this is taught in Fig. 81, 8120 or cols. 54-60 or ADLER paragraphs [0165].

As for dep. claims 13-14 (part of 9 above) which deal with architecture (organization structures) parameters for the business enterprise and the information technology, these are fairly taught in cols. 41-42, 44-53, Figs. 81, 83-85, etc. Moreover, these terms or structures appear to be non-functional in a data processing system.

As for dep. claims 15-17 (part of 9 above), which deal with the architecture changing parameters, i.e. customizing it to a particular instance, etc., these are fairly taught in cols. 54, 68, etc. These are also taught in ADLER abstract or Figs. 1, 1A., 4 and paragraph [0017].

Response to Arguments

8. Applicant's arguments with respect to the previous rejections have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

No claims are allowed.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689